IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Jay S. Walker, Andrew S. Van Luchene

Application No.: 09/045,036

Filed: March 20, 1998

For: SYSTEM AND METHOD FOR FACILITATING THE PLAY OF FRACTIONAL LOTTERY TICKETS USING POINT-OF-SALE TERMINALS

Group Art Unit: 3622

Examiner: John L. Young

REPLY BRIEF

Attorney Docket No. 97-558

Customer No. 22927

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Dated: October 31, 2003 By: V. L. Leliever
Veronika S. Leliever

BOARD OF PATENT APPEALS AND INTERFERENCES

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner:

Appellant hereby replies to the Examiner's Answer mailed September 16, 2003 (Paper No. 18).

Appellants respectfully address the following issues which were raised by the Examiner's Answer.

Contents of Examiner's Answer

Pages 4 - 24 of the Examiner's Answer are a duplicate of pages 3 - 22 of the Final Office Action mailed June 25, 2002. These rejections have been addressed by the Appeal Brief filed June 30, 2003 (Paper No. 17).

Likewise, pages 25 - 45 are arguments which are set forth almost identically in the Final Office Action. Thus, almost all of these arguments have been addressed by the Appeal Brief filed June 30, 2003.

Those portions of the Examiner's Answer which are not identically set forth in the Final Office Action are addressed below.

Appellants note that several arguments presented in the Appeal Brief have not been addressed by the Examiner's Answer. Other arguments presented in the Appeal Brief have been merely disputed without any reasoning or support at all. Still other arguments presented in the Appeal Brief have not been rebutted with anything except general statements regarding, e.g., the law of obviousness.

Examiner's Answer, page 25, paragraph 1

The Examiner contends that the allegations in the Appeal Brief of no prima facie case of unpatentability amount to "a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references." Apparently, the implication is that Appellants have somehow failed to make some required showing.

This is clearly incorrect for two reasons. First, if a prima facie case has not been made, Appellants have absolutely no obligation to specifically indicate patentability. Second, Appellants have nevertheless clearly indicated how the claims distinguish from the references.

Regarding the first reason, if a prima facie case of unpatentability has not been made, then **without more** the applicant is entitled to grant of the patent. In re Oetiker, 977 F.2d 1443,

1445 (Fed. Cir. 1992) (emphasis added). The Appeal Brief, Section 1.3, pages 15 - 16 contains authorities and arguments for this proposition. Since the absence of a prima facie case of unpatentability mandates that a patent be granted, Appellants have no additional duty to demonstrate patentability since the prima facie case has not been made.

Regarding the second reason, Appellants have, in any event, clearly indicated how the claims distinguish from the references. The Appeal Brief contains, for each Group of claims, sections which demonstrate the advantages of various limitations of the claims (Sections 1.2, 2.2, 3.2, 4.2, 5.2, 6.2, 7.2, 8.2, 9.2, 10.2, 11.2 and 12.2) and why the limitations are not suggested by the references, alone or in combination (Sections 1.3 et seq., 2.3 et seq., 3.3 et seq., 4.3 et seq., 5.3 et seq., 6.3 et seq., 7.3 et seq., 8.3 et seq., 9.3 et seq., 10.3 et seq., 11.2 et seq. and 12.2 et seq.).

Examiner's Answer, page 28, paragraph 2

The Examiner contends that "the features upon which Appellant [sic] relies (e.g., 'a 26% share of a $1 lottery ticket ...' etc.) are not recited in rejected claim 1."

However, nowhere in the Appeal Brief have Appellants relied upon this or any other limitations not explicitly recited in the claims. The portions of the Appeal Brief cited by the Examiner are clearly indicated as examples only of the arguments which precede them.

Examiner's Answer, page 29, paragraph 3 - page 30, paragraph 1
Examiner's Answer, page 31, paragraph 4 - page 32, paragraph 1

The Examiner refers to specific portions of Storch as showing "coding of lottery tickets" or "coding of lottery tickets with identifiers". The Examiner then interprets these portions as suggesting the entirety of claim 1. No further clarification is provided, and there is no further rebuttal of the arguments presented in the Appeal Brief regarding the patentability of claim 1.

Section 1.3.1 of the Appeal Brief (pages 17 - 20) discusses these cited portions of Storch, and the failure of Storch to suggest the limitations of claim 1.

Examiner's Answer, page 33, paragraphs 1 - 3

In a similar assertion, the Examiner refers to specific portions of Storch as showing "coding of lottery tickets with identifiers". The Examiner then interprets these portions as suggesting "storing the ticket identifier and the portion identifier". No further clarification is provided, and there is no further rebuttal of the arguments presented in the Appeal Brief regarding the patentability of claim 1.

Section 1.3.3 of the Appeal Brief (pages 21 - 22) discusses these cited portions of Storch, and the failure of Storch to suggest "storing the ticket identifier and the portion identifier".

CONCLUSION

If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact Dean Alderucci using the information provided below.

Respectfully submitted,

October 31, 2003
Date

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